

### **REMARKS**

In the Office Action mailed November 5, 2004, claims 1, 12, 21-24 and 41 were rejected under 35 U.S.C. 102(b). Claim 20 was rejected under 35 U.S.C. 103(a).

### **Amendments**

Claims 1 and 41 have been amended to specify that m is an integer from 2 to 20. The amendments to "m" in claims 1 and 41 are supported by the specification as filed on page 3, line 14, and claim 1 as originally filed, for example. Claims 1, 40 and 41 have been amended to clarify the definition of "X". The amendments to the "X" group in claims 1, 40 and 41 are supported by the specification as filed, for example, compounds exemplified in the Tables on pages 24-25. The "R<sup>1</sup>" and "R<sup>3</sup>" groups in claim 2 have been amended. The amendments to the "R<sup>1</sup>" and "R<sup>3</sup>" groups in claim 2 are supported by the specification as filed, including page 25, lines 5-6 and compounds exemplified in the Tables on pages 24-25. Claim 8 has been amended to specify the lactone ring found in the elected compound. The amendment to claim 8 is supported by the specification as filed, including page 25, lines 5-6. New claim 43 has been amended to particularly claim the elected compound. New claim 43 is supported by the specification as filed, including page 25, line 6. New claim 44 is added which specifies CR does not contain two adjacent chiral carbon atoms. New claim 44 is supported by the specification as filed, including the compounds exemplified in the Tables on pages 24 and 25, as well as page 5. Claim 45 has been added to specify CR contains a five-membered lactone ring that does not contain two adjacent chiral carbon atoms. New claim 45 is supported by the specification as filed on page 5, lines 1-4 and page 25, lines 5-6. New claim 46 is added which specifies the elected compound in the composition of claim 44. New claim 46 is supported by the specification and claims as filed. No new matter is added by the amendments, and all amendments are supported by the specification and claims as originally filed.

### Election/Restriction

Applicant confirmed the election of compound 1401, with traverse in the response mailed January 23, 2004 to the Office Action mailed July 25, 2003. The non-elected claims are withdrawn from consideration without prejudice. Claims 2, 8 and 40 have been amended to read on the elected compound and should be included in the claims under consideration. Claim 42 depends from claim 40 and should be included in the claims under consideration. New claims 43-46 read on the elected compound and should be included in the claims under consideration.

### 35 U.S.C. 102(b) rejection

In the Office Action mailed November 5, 2004, claims 1, 12, 21-24 and 41 were rejected under 35 U.S.C. 102(b) over JP 7-309858. The Office Action stated "the reference discloses an optically active compound having lactone group shown in formulae I and III. . . The reference anticipates the claimed invention because the right-hand side group of the reference, X2-L1(or L2)-A4-R2, is a chiral group."

Applicant can not locate any compounds exemplified in the translated copy of JP 7-309858 provided by the Examiner that contain the partially fluorinated tail group now required in claims 1 and 41. Claims 1 and 41 have been amended to specify variable "m" is at least 2. In Applicant's reading of the JP 7-309858 reference, where partially fluorinated tail groups are shown, the fluorinated alkyl tail groups contain only one -CH<sub>2</sub>- linker (corresponding to m=1 in Applicant's claims). Group (v) of paragraph [0041] in the JP 7-309858 reference does use variables h and i in a fluorinated tail, but the heading of paragraph [0041] is "Formula 2" which is described in the abstract as a reactant in the synthesis of other compounds. Assuming for the sake of argument only, without conceding to the Examiner's position, using the synthesis shown in paragraph [0048] of the JP 7-309858 reference, the partially fluorinated group in the resulting compound would be at the opposite end of the structure from that found in the claims of the present application. Therefore, independent claims 1 and 41, and claims dependent therefrom are believed not anticipated by the JP 7-309858 reference.

With respect to independent claims 40 and 44, all compounds exemplified and described in the translated copy of JP 7-309858 provided by the Examiner include rings L1 and L2, which contain two adjacent chiral carbon atoms. Claim 44 specifies the CR tail group does not contain two adjacent chiral carbon atoms. The "CR" groups in claim 40 do not contain two adjacent chiral carbon atoms. Therefore, it is believed independent claims 40, 44 and claims dependent therefrom are not anticipated by the JP 7-309858 reference. Claim 43 is the elected compound, which was said to be allowable.

All limitations of the claims as amended are not found in the cited reference. Therefore, the rejection is believed overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

#### 35 U.S.C. 103(a) rejection

In the Office Action mailed November 5, 2004, claim 20 was rejected under 35 U.S.C. 103(a) over JP 7-309858. The Office Action stated: "The reference differs from the claim in that the claim has same number of m and n. Because the notations h and i in group (v) on page 4 are from 1 to 10 and 0 to 7, respectively, it would have been obvious to those skilled in the art to select the same number for m and n to arrive at the claimed invention."

In response, as stated above, group (v) of the JP 7-309858 reference describes formula 2. It would not be obvious to use the teachings cited in the Office Action regarding group (v) to prepare or use a compound which contains the partially fluorinated tail claimed in claim 20. Without conceding or agreeing to the Examiner's interpretation of the reference, assuming for the sake of argument only, that formula 2 could contain  $h = i$ , using the synthesis shown in paragraph [0048] of the JP 7-309858 reference, the partially fluorinated group in the resulting compound would be at the opposite end of the structure from that found in the claims of the present application. In

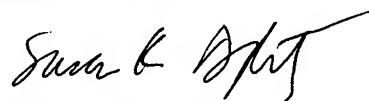
view of the arguments and amendments, the rejection of claim 20 is believed overcome. Reconsideration and withdrawal of the rejection is respectfully requested.

### **CONCLUSION**

In view of the above arguments and amendments, it is believed the claims are allowable. Reconsideration and withdrawal of all rejections and objections is respectfully requested. If there are any issues remaining to patentability, the Examiner is respectfully requested to telephone the undersigned.

This response is accompanied by a petition for a three month extension of time and a check for the amount of \$1520 (fee for extension of time and fee for two independent claims and two dependent claims). If the fees submitted are incorrect, however, please deduct the appropriate amount, including the fee for any extensions of time required, or credit any overpayment to Deposit Account 07-1969.

Respectfully submitted,



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